REMARKS

Summary of the Office Action

Claims 1, 3, 5-8, 9, 13, 15, 17 and 19 stand provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 3, 9 and 15-21 of copending application no. 10/752,215 (hereinafter "the '215 application").

Claims 2, 4, 14, 16, 18 and 20 stand provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 3, 9 and 15-21 of the '215 application as applied to claims 1, 3, 5-8, 9, 13, 15, 17 and 19 of the instant application and further in view of Ito et al. (U.S. Patent No. 6,598,101) (hereinafter "Ito").

Claims 1-12 stand rejected under 35 U.S.C. § 101 as allegedly being directed to non-statutory subject matter.

Claims 1 and 9 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Komoda et al. (U.S. Patent No. 6,701,063) (hereinafter "Komoda").

Claims 2 and 4 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Komoda as applied to claims 1 and 9 above, and further in view of Ito et al. (U.S. Patent No. 6,598,101) (hereinafter "Ito").

Claims 3 and 5-8 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Komoda in view of Inoue et al. (U.S. Patent Application Publication No. 2001/0006579) (hereinafter "Inoue").

Claims 10-12 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Ito and further in view of Inoue.

Claims 13, 15, 17 and 19 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Komoda as applied to claims 1 and 9 above, and further in view of Yokota (U.S. Patent No. 5,754,521) (hereinafter "Yokota").

Claims 14, 16, 18 and 20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Komoda and Ito as applied to claims 1, 2, 4 and 9 above, and further in view of Yokota.

Summary of the Response to the Office Action

Applicants have amended claim 10 to differently describe embodiments of the disclosure of the instant application and/or to improve the form of the claims. Accordingly, claims 1-20 remain currently pending for consideration.

Double Patenting Rejections

Claims 1, 3, 5-8, 9, 13, 15, 17 and 19 stand provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 3, 9 and 15-21 of the '215 application. Claims 2, 4, 14, 16, 18 and 20 stand provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 3, 9 and 15-21 of the '215 application as applied to claims 1, 3, 5-8, 9, 13, 15, 17 and 19 of the instant application and further in view of Ito. These rejections are respectfully requested to be withdrawn for at least the following reasons.

According to MPEP § 804(I)(B)(1), if a "provisional" nonstatutory obviousness-type double patenting (ODP) rejection is the only rejection remaining in the earlier filed (i.e. the present patent application filed on December 3, 2003 and having a Japanese priority date of

December 4, 2002) of the two pending applications, while the later-filed application (i.e., the copending '215 application, filed on January 7, 2004 and having a Japanese priority date of January 7, 2003) is rejectable on other grounds, the examiner should withdraw that rejection and permit the earlier-filed application to issue as a patent without a terminal disclaimer. In the instant application, the remaining rejections should be withdrawn for the reasons explained in detail in the following sections of the instant remarks. Accordingly, as the instant application is the "earlier-filed" of the applications applied in these provisional nonstatutory obviousness-type double patenting rejections, withdrawal of the double patenting rejections is respectfully requested at least for the above-stated directives from MPEP § 804(I)(B)(1).

Rejections under 35 U.S.C. § 101

Claims 1-12 stand rejected under 35 U.S.C. § 101 as allegedly being directed to non-statutory subject matter. The Examiner asserts that independent claims 1 and 10 "are directed to a recording medium containing video data, wherein the video data is consider to be nonfunctional descriptive material."

Applicants respectfully traverse these rejections because independent claims 1 and 10 of the instant application, and their dependent claims, are written consistent with the directives of well-established U.S. case law, such as In re Lowry, 32 F. 3d 1579 (Fed. Cir. 1994) which is quoted in MPEP § 2106.IV.B.1 for the proposition that a "claim to data structure stored on a computer readable medium that increases computer efficiency held statutory."

Applicants respectfully submit that on the recording medium described in claims 1-9 of the instant application, there are recorded (i) "first entity information" which has a functionality

to constitute Titles which are compressed and encoded by a first compressing and encoding method (e.g., MPEG2), (ii) "second entity information" which has a functionality to constitute Titles which are compressed and encoded by a second compressing and encoding method (e.g., MPEG4), (iii) "first management information" which has a functionality to manage and control the first entity information and (iv) "second management information" which has a functionality to manage and control the first and second entity information.

More particularly, Applicants respectfully submit that the recording medium described in claims 1-9 of the instant application does not merely contain non functional descriptive material (e.g., abstract idea) as asserted by the Examiner in the Office Action. Instead, the recording medium described in these claims includes a plurality of functional descriptive material (functional information) recorded thereon in the form of the specifically recited first and second entity information and first and second management information. Each of these types of information is a data structure that has a technical and/or functional relationship with regard to the others as described previously.

Applicants respectfully submit that because such information types having the previously-described functionalities are recorded on the recording medium, (i) it is possible to reproduce the first and second information to refer to the second management information without reference to the first management information, when the information recording medium is reproduced by the information recording reproducing apparatus which can reproduce both the first and second entity information. See, for example, page 5, line 19 – page 6, line 17 of the specification of the instant application. Also, (ii) it is possible to reproduce the first information to refer to the first management information, when the information recording medium is

reproduced by the information recording reproducing apparatus which does not have a function of reproducing the second entity information but which can reproduce the first entity information. See, for example, page 6, line 18 – page 7, line 9 of the specification of the instant application.

More particularly, the recording medium described in claims 1-9 can achieve a significant technical effect such that it is possible to perform the different reproduction control (i.e., reproduction control based on the first management information and reproduction control based on the second management information), depending on whether or not the information reproducing apparatus can reproduce the second entity information.

Furthermore, Applicants respectfully submit that on the recording medium described in claims 10-12, there is recorded (i) "entity information" which has a functionality to constitute Titles which are compressed and encoded by a predetermined compressing and encoding method (e.g., MPEG2/MPEG4) and (ii) "management information" which has a functionality to manage and control the entity information, and the management information includes (iii) "number information" which has a functionality to indicate an identification number of the entity information which is uniquely given to each Title, (iv) "total number information" which has a functionality to indicate the total number of the entity information and (v) "information" which has a functionality to indicate a fact that there is no record of another entity information compressed and encoded by another compressing and encoding method.

More particularly, Applicants respectfully submit that the recording medium described in claims 10-12 is not a recording medium that contains only nonfunctional descriptive material (e.g., an abstract idea) as asserted by the Examiner in the Office Action. Instead, the recording

medium of these claims includes a plurality of functional descriptive material (functional information) recorded thereon, such as "entity information" and "management information" including the above-described "number information" and the like which have specific technical and/or functional interrelationships between each other.

Applicants respectfully submit that because such information having particular functionalities and interrelationships are recorded on the recording medium, the recording medium described in claims 10-12 can achieve a significant technical effect such that an information reproducing apparatus that is compatible with several compressing and encoding methods (e.g., MPEG2/MPEG4) can perform efficient reproduction control by referring to the number information and the total number information. See, for example, page 19, line 13 – page 20, line 1 of the specification of the instant application.

Accordingly, for at least the foregoing reasons, Applicants respectfully submit that the "recording medium" claims 1-12 of the instant application achieve the above-described technical effects by including particular data structures having respective functionalities and interrelationships with the other data structures. Thus, Applicants respectfully submit that these data structures are clearly not mere "non-functional descriptive materials" such as music, or an abstract idea, for example, as asserted by the Examiner in the Office Action. Instead the above-described data structures recited in claims 1-12 of the instant application are clearly functional and clearly increase computer efficiency as discussed previously, and as will be discussed in even more detail in the following remarks regarding the rejections under 35 U.S.C. §§ 102(b) and 103(a).

As a result, claims 1-12 of the instant application are clearly statutory as per the above-stated directives in the November 2005 Interim Guidelines and MPEP § 2106. Accordingly, withdrawal of the rejection under 35 U.S.C. § 101 is respectfully requested.

To the extent that the Examiner might choose to reapply any of these rejections under 35 U.S.C. § 101, Applicants respectfully request that the Examiner show any such rejected claims to the 35 U.S.C. § 101 Examining Panel within the USPTO to confirm that such rejections are proper. In the interest of compact prosecution, the Examiner is requested to contact Applicants' undersigned representative by telephone once the panel has reviewed any such claims and has reached a determination in this regard as to the current form of the claims. It would be appreciated if the Examiner would work with Applicants' undersigned representative in this way to obtain resolution of this issue. For example, if the 35 U.S.C. § 101 Panel happens to determine that the rejection under 35 U.S.C. § 101 is still proper, but a minor amendment could be implemented to overcome the rejection under 35 U.S.C. § 101, it would be appreciated if the Examiner would place a telephone call to Applicants' undersigned representative to resolve such a situation in an efficient manner.

Rejections under 35 U.S.C. §§ 102(b) and 103(a)

Claims 1 and 9 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Komoda. Claims 2 and 4 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Komoda as applied to claims 1 and 9 above, and further in view of Ito. Claims 3 and 5-8 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Komoda in view of Inoue. Claims 10-12 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Ito and further in view of

Inoue. Claims 13, 15, 17 and 19 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Komoda as applied to claims 1 and 9 above, and further in view of Yokota. Claims 14, 16, 18 and 20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Komoda and Ito as applied to claims 1, 2, 4 and 9 above, and further in view of Yokota.

With regard to claims 1-9 and 13-20, these rejections are respectfully traversed for at least the following reasons. Applicants respectfully submit that Komoda does not disclose the novel features of claims 1-9 and 13-20 of at least "second management information" which has a functionality to manage and control both of the first and second entity information.

More specifically, Applicants respectfully submit that although the cited Komoda reference discloses "directories 201 to 203," the (sub) directory 202 manages only video data 204/205 which are encoded by video standard (MPEG2) and the (sub) directory 203 manages only video data which are encoded by another method (JPEG method) different from the video standard. Namely, Applicants respectfully submit that Komoda does not disclose the generic directory for managing both the video data 204/205 which are encoded by a video standard (MPEG2) and another video data which are encoded by another method.

Applicants respectfully submit that the additionally applied references to Ito, Inoue and Yokota do not disclose at least the "second management information" which has a functionality to manage and control both of the first and second entity information to any extent. Withdrawal of the rejections of claims 1-9 and 13-20 is thus respectfully requested.

Applicants have amended independent claim 10 to differently describe embodiments of the disclosure of the instant application and/or to improve the form of the claims. To the extent

that these rejections might be deemed to still apply to the claims as newly-amended, they are respectfully traversed for at least the following reasons.

Applicants respectfully submit that they have newly-amended independent claim 10 to describe "management information for managing and controlling said entity information and for being capable of managing and controlling one or a plurality of entity information which is compressed and encoded by another compressing and encoding method, which is different from the predetermined compressing and encoding method," in a manner similar to that described in originally filed independent claim 1 and the like.

As described previously, the cited references to Komoda, Ito, Inoue and Yokota do not disclose at least the novel feature of amended claims 10-12 of "management information" which has a functionality to manage and control both of the plurality of types of entity information to any extent. Withdrawal of the rejections of claims 10-12 is thus respectfully requested.

CONCLUSION

In view of the foregoing, Applicants submit that the pending claims are in condition for allowance, and respectfully request reconsideration and timely allowance of the pending claims. Should the Examiner feel that there are any issues outstanding after consideration of this Supplemental Amendment, the Examiner is invited to contact Applicants' undersigned representative to expedite prosecution. A favorable action is awaited.

EXCEPT for issue fees payable under 37 C.F.R. § 1.18, the Commissioner is hereby authorized by this paper to charge any additional fees during the entire pendency of this application including fees due under 37 C.F.R. § 1.16 and 1.17 which may be required, including

any required extension of time fees, or credit any overpayment to Deposit Account No. 50-0573.

This paragraph is intended to be a **CONSTRUCTIVE PETITION FOR EXTENSION OF TIME** in accordance with 37 C.F.R. § 1.136(a)(3).

Respectfully submitted,

DRINKER BIDDLE & REATH LLP

Dated: November 21, 2007 By: _____

Paul A. Fournier
Reg. No. 41,023

Customer No. 055694
Drinker Biddle & Reath LLP
1500 K Street, N.W., Suite 1100
Washington, DC 20005-1209
Tel.: (202) 842-8800
Fax: (202) 842-8465